



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

JGJR.: 06-06

Paper No: \_\_

CALFEE HALTER  
& GRISWOLD, LLP  
800 SUPERIOR AVENUE  
SUITE 1400  
CLEVELAND OH 44114

**COPY MAILED**

**JUL 03 2006**

**OFFICE OF PETITIONS**

In re Application of  
Fox, et al.  
Application No.: 10/695,040  
Filing Date: 27 October, 2003  
Attorney Docket No. 21220/04146

:  
:  
:  
:  
:

**DECISION**

This is a decision on the petition filed on 3 April, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, alternatively seeking to revive under 37 C.F.R. §1.137(a) (alleging unavoidable delay) or under 37 C.F.R. §1.137(b) (unintentional delay).

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; and the petition under 37 C.F.R. §1.137(a) is **GRANTED** and the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**.

**REMINDER:** Petitioner may find that the filing of Status Inquiries at three- or four-month intervals following the filing of substantive papers may not only obviate delays in the Office addressing a matter but also **evidencing** diligence.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to a Restriction requirement mailed by the

Examiner on 27 January, 2005, with reply due absent extension of time on or before Monday, 28 February, 2005;

- the application went abandoned after midnight 27 February, 2005;
- Petitioner acknowledges that on or about 27 April, 2005, fully within the statutory reply time, Petitioner learned that the Office action had been mailed on 27 January, 2005;
- the Office mailed the Notice of Abandonment on 1 August, 2005;
- Petitioner indicates he took no action in the three and one-half months between 27 April, 2005, and receipt of the Notice of Abandonment;
- Petitioner filed the original petition on 15 August, 2005, seeking withdrawal of the holding of abandonment, and, while Petitioner provided copies of docket sheets, Petitioner did not make the statement of his review of the file jacket, and so did not satisfy the strict construction of the requirements set out at MPEP §711.09 c), and the petition was dismissed on 26 February, 2006, for failure to make the required showing and failure to file within two months of the known abandonment;
- while the instant petition does not expressly request withdrawal of the holding of abandonment, Petitioner nonetheless does aver an attempt to satisfy the Delgar<sup>1</sup> showing, and alternatively Petitioner expressly seeks revival as abandoned due to unavoidable or unintentional delay, and Petitioner—in light of his earlier submissions—further satisfies the reply and certain showing/statement requirements under 37 C.F.R. §1.137.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is

---

<sup>1</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

#### Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup>

Petitioner did not satisfy the timeliness requirements.

#### Allegations as to Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a statement/showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

---

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

Petitioner appears to have satisfied the requirements.

Allegations as to  
Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

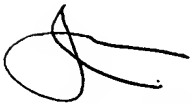
It matter is moot.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **dismissed**; however, the petition under 37 C.F.R. §1.137(a) is **granted**; and the petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The instant application is released to the Examiner in Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions